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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,915	01/10/2006	Konsei Shino	P29144	5640
7055 7590 09/19/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER CUMBERLEDGE, JERRY L	
			ART UNIT 3733	PAPER NUMBER
			NOTIFICATION DATE 09/19/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
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Office Action Summary

Application No.

10/563,915

Applicant(s)

SHINO, KONSEI

Examiner

Jerry Cumberledge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2007 and 10 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmieding (US Pat. 6,270,503 B1).

Schmieding discloses a device for ligament reconstruction (Fig. 6) comprising: a tip (Fig. 6, ref. 16) and body (Fig. 6, middle portion near ref. 10) each having at least two parallel through-holes (Fig. 6, ref. 12) formed therein in juxtaposition (Fig. 12), wherein said body is connected to an outer peripheral longitudinal extending surface of said tip (Fig. 12, outer surface of ref. 16); and a rear-end (Fig. 6, ref. 14) having at least two rear-end through-holes (Fig. 6, ref. 12) (Fig. 7) extending in juxtaposition coaxially with the through-holes formed in said tip and body (Fig. 6)(Fig. 7), wherein said tip and body has either one of a uniform generally elliptical (Fig. 7)(Fig. 12) or generally rectangular cross section elongated in a direction in which the through-holes thereof are juxtaposed, said rear-end being configured to drive said tip and body into a bone which receives ligament reconstruction (Fig. 6). The generally elliptical or rectangular cross section of said tip has a major axis/minor axis ratio of 2 to 5, since the cross section could be taken at an angle with respect to the longitudinal axis of the device. The elliptical cross section of said tip is of a generally oval shape or a racetrack-like elliptical shape (Fig.

6)(Fig. 7). The ligament reconstruction is reconstruction of an anterior cruciate ligament (Fig. 6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmieding (US Pat. 6,270,503 B1).

Schmieding discloses the claimed invention except for the tip and body having a cross sectional area of 21 mm² to 84 mm²; the racetrack-like elliptical shape being defined by a pair of parallel straight lines spaced a distance of 3mm to 6mm from each other and each having a length of 4mm to 8mm and a pair of semicircles connecting opposite ends of the straight lines. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the tip and body of Schmieding having a cross sectional area of 21 mm² to 84 mm²; the racetrack-like elliptical shape being defined by a pair of parallel straight lines spaced a distance of 3mm to 6mm from each other and each having a length of 4mm to 8mm and a pair of semicircles connecting opposite ends of the straight lines, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

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Schmieding discloses the claimed invention except for a rectangular cross section of said tip has a minor edge length of 3mm to 6mm and a major edge length of 7mm to 14mm. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to have constructed the device of Schmieding with a rectangular cross section of said tip having a minor edge length of 3mm to 6mm and a major edge length of 7mm to 14mm, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of forming a cavity in bone. In re Dailey and Eilers, 149 USPQ 47 (1966).

Response to Arguments

Applicant's arguments with respect to the obvious ranges have been considered, but they are not persuasive. The passages cited by the Applicant refer to the general shape of the device, not the disclosed ranges. The Examiner asserts that the ranges disclosed by the Applicant are obvious variations of the prior art that has been cited previously and is currently being cited. Regarding the ranges, Applicant's arguments do not overcome the rejections applied thereto, since applicant has not provide any convincing showing that these are nothing more than optimum or workable values as asserted by the examiner. Applicant has not provided any showing that such limitations are "critical". In re Cole, 140 USPQ 230 (CCPA 1964); In re Kuhle, 188 USPQ 7 (CCPA 1975); In re Davies, 177 USPQ 381 (CCPA 1973). Mere arguments by counsel cannot

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take the place of evidence. In re Cole, 236 F.2d 769, 773, 140 USPQ 230, 233 (CCPA 1964); In re Walters, 168 f.2d 79, 80, 77 USPQ 609, 610 (CCPA 1948); et al.

As for the shape of the device, the Examiner notes that the device as disclosed and claimed can be either elliptical or rectangular. This indicates that the two shapes are at least obvious variations of each other, since the device can be either elliptical or rectangular.

Applicant's remaining arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

Claims 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

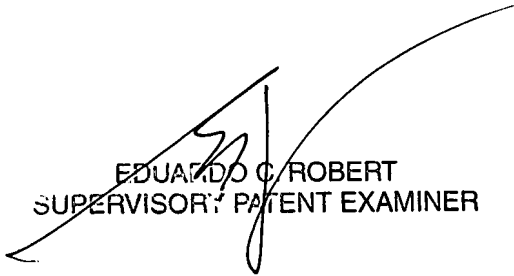
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Cumberledge whose telephone number is (571) 272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLC



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER